REMARKS

Claims 1-9 are all the claims pending in the application. Applicants have canceled claims 1, 2, and 8 in this Amendment.

Applicants thank the Examiner for acknowledging Applicants' claim for foreign priority, but request that the Examiner explicitly acknowledge receipt of the certified priority document (JP 2000-180509) in the next Office Action. Further, Applicants kindly request that the Examiner acknowledge acceptance of the drawings in the next Office Action. In addition, Applicants also request that the Examiner provide a signed PTO-1449 for the March 22, 2004 IDS.

Claim Rejections - 35 USC § 103

Claims 1, 2 and 8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ito (U.S. Patent No. 6,330,529) in view of Tso et al. (U.S. Patent No. 6,421,733). Applicants have canceled these claims by this Amendment, soley to advance prosecution of certain other embodiments of the present invention.

Claims 3-7 and 9 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Ito and Tso et al. and further in view of Furst (U.S. Patent No. 6,297,819) and Yates et al. (U.S. Patent No. 6,330,586). Applicants have amended independent claims 3, 6, and 9 solely to recite certain embodiments of the present invention including a translation instructing banner.

A non-limiting description of this translation instructing banner can be found on page 14, line 23 to page 15, line 10 of the present specification. In particular, the contents server 50 stores

contents 51 provided by the contents provider and transmits contents 51 to the translation server 70, by request of the conversion server 70 based on an instruction of a translation instructing banner 61. A translation instructing banner 52 is arranged and contained in the contents 51 by the contents provider, whereby the translation instructing banner 52 is acquired by user terminal 60 and displayed thereat as the translation instructing banner 61. The user terminal 60 is made up of, for example, a personal computer or the like and is used to select and display contents 51 stored in the contents server 50, by manipulation of the user and, based on an instruction of the translation instructing banner 61, transmits translation implementing request information 160 to make a request of the translation server 70 for the translation of the displayed contents 51 to the translation server 70, and to input and display a translated result I73a of the contents 51.

In addition to the translation instructing banner, Applicants submit that other features recited in the claims are not found in the cited art. Ito is generally related to a translation system. With respect to these claims, the Examiner states that Ito teaches a grammar based translation system and method, comprising an information providing apparatus (citing column 3, lines 57-60); a contents server to store contents provided by a contents provider (citing column 3, lines 57-60); a user terminal to be operated by a user (citing column 3, lines 60-63); and a translation computer system (citing column 4, lines 8-25).

The Examiner does, however, acknowledge that Ito does not teach the feature recited in the claims whereby a contents provider is charged a conversion fee for contents conversion performed by the conversion server. Yet, the Examiner further argues that Tso et al. teach a system and method for dynamically transcoding data transmitted between computers, wherein

web-page content is translated to a user's native language (citing column 8, lines 42-43 and col. 16, lines 36-38); and wherein a web-site provider (owner) pays a proxy provider to improve the performance of all users (*sic*) while visiting the provider's (owner's) site (citing column 16, lines 36-38). Thus, the Examiner alleges that it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Ito to include a feature whereby the contents provider is charged a fee for contents conversion performed by the translation computer system, because it would increase the amount of potential (foreign-speaking) customers for the content provider, and generate funds for an owner of the translation computer system, which (funds) are necessary to operate the business.

Applicants respectfully submit that the Examiner's obviousness rejection is based on improper hindsight and also mischaracterizes the teachings of Tso et al. As can be seen by the Examiner's rejection, the motivation to combine the Ito translation system with the Tso et al. transcode service provider was not provided by the Ito patent, by Tso et al., or othewise. In fact, Applicants submit that Ito is silent with respect to any discussion of charging conversion (translation) fees.

With respect to Tso et al., the citations that the Examiner refers to are paying a proxy provider to improve the performance of the users (*sic*) while visiting the owner's site. The concept of improving a user's performance is earlier described in col. 16 as giving users a higher priority when competing with other users for proxy services (see col. 16, lines 15-23), rather than servicing them on a random or first come/first-served basis. Thus, the concept suggested by Tso et al. is providing preferential treatment (VIP treatment (see col. 16, lines 17 and 18)) when

accessing proxy services. For example, one of ordinary skill in the art would have understood that the citation of a web site owner paying a proxy provider in the *full context* of the teachings of Tso. et al. would mean, based on the use of the terms "all users" that the website owner would pay a fee to have the proxy server service the users to its website in a manner faster than that of users requesting access to another website. Tso et al. also teach that users themselves may pay for the service, therefore teaching away from the present invention (see col. 16, lines 33-36). Thus, the passing mention in Tso et al. of a *payment* for preferential treatment (an entirely different concept and not suggestive of charging a conversion fee) coupled with Tso et al. also teaching (away) that the user pay for preferential treatment does not disclose or suggest the recited feature of charging a conversion fee, nor therefore would there be motivation to incorporate the Tso et al. transcode service provider with the Ito translation system.

In addition, the motivation to combine the Ito translation system with the Tso et al. transcode service provider is not suggested by the nature of the problem to be solved. *See Pro-Mold v. Great Lakes Plastics, 75 F.3d 1568, 1573 (Fed. Cir. 1996).* One of the problems solved by the present invention is the inconvenience and costs associated with charging translation fees directly to a user (see specification at page 4). As such, one of the features of the present invention, as recited in the independent claims, is *charging* the content provider for contents conversion performed by the conversion server.

In Ito, the problem solved is providing a translation system that allows a converted document to be further worked on after it has been converted and displayed on a user screen (see

col. 1, lines 24-50). Again, for the reasons discussed above, Ito does not teach or suggest the feature of charging for a conversion fee.

Tso et al. solves the problem of existing (at the time) proxy servers not being able to manipulate data passing through them. As discussed above, Tso et al. provides only a passing mention of a "pay" feature that is certainly not related in any manner to the problem solved by Tso et al.

Applicants note that the Federal Circuit warns about the risk of hindsight reconstruction to find an invention obvious where the invention at issue involves relatively simple technology. *See McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351 (Fed. Cir. 2001). Even, *assuming arguendo*, that the individual features were disclosed in parts of each patent, since the motivation to combine the individual features is not found in the disclosure of the patents themselves, or by the problem they solve, Applicants respectfully submit that the rejection is based on hindsight using the Applicants' own specification, which is improper. Accordingly, Applicants submit that claims 3-7 and 9, each including the conversion fee charging system feature are allowable for this reason as well.

Further, the Examiner acknowledges that Ito and Tso et al. do not teach showing a method of charging for conversion of said contents; registering said contents information and contents provider information; and collecting use history information for determining said conversion fee. The Examiner states that Furst teaches a system and method for translating a web-page from its native language into a desired language (citing column 11, lines 65-67), wherein service providers are registered with the system (citing column 6, lines 52-55), and

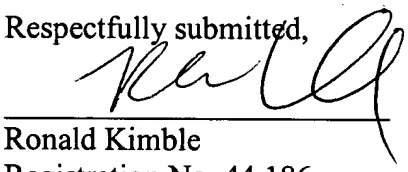
wherein payment options (subscription information) are shown on a display (citing column 10, lines 26-28). Based on this disclosure, the Examiner states that it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Ito and Tso et al. to include registering service providers with the system as taught by Furst, because it would allow a record of services offered as subscriptions for the users. Applicants respectfully traverse this assertion. As recited in the claims, the contents information and the contents information provider are registered on the conversion server. While Furst discusses a general concept of registration, this registration is related to registering applications (see col. 2, lines 5-30 for an explanation of applications) - not to content information.

In addition, the Examiner states that Yates et al. teach a system and method for service provision by means of communications networks, wherein usage record and accrued charges are monitored (citing column 19, lines 49-50). Therefore, the Examiner states that it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Ito, Tso et al. and Furst to include monitoring of usage, as taught by Yates et al., because it would allow to provide discounts for said subscriptions to the most frequent users thereby stimulating the users to increase their usage time and profits to the system owners. Applicants respectfully submit that based on the lack of teachings of the invention by Ito, Tso et al. and Furst for the reasons above, that the addition of a generic reference to usage records in Yates et al. would not render the present invention obvious. Accordingly, Applicants submit that claims 3-7 and 9 are allowable for the reasons discussed above.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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